

## REMARKS

As a preliminary matter, Applicant has amended the specification and claim 4 to correct for informalities, and the abstract to more appropriately reflect the invention as claimed.

Claim 8 stands rejected under 35 U.S.C. 112 second paragraph, as being indefinite. In response, Applicant has amended claim 8 to delete “and the like” language from the claim. Thus, withdrawal of the objection to claim 8 is respectfully requested.

Claims 1-2, 4-5, and 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by the publication, “WebMate: A Personal Agent for Browsing and Searching,” Chen et al., Proceedings of the 2<sup>nd</sup> International Conference on Autonomous Agents, May, 1998, NY, USA, ACM Press, pages 132-139, hereinafter “WebMate.” Applicant respectfully traverses the rejection because the cited reference does not disclose (or suggest) a search condition designating unit that designates a file as a search condition and transmits contents of the designated file via a network for a search requesting source, and a document search unit that forms a keyword from the file contents transmitted from the search condition designating unit and searches similar documents.

WebMate is a system that learns a user profile to compile information in two ways. The first way is to automatically spide a list of URLs that the user wants monitored. For example, news headlines can be monitored. WebMate parses the HTML page, extracts the links of each headline, fetches the extracted pages, constructs a vector for each of those pages using data such as words in the title and the headings, and calculates a similarity with a

current profile. If the similarity is greater than a threshold, it recommends a page to a user, and sorts all recommended pages. Second, if a user does not provide any URLs that would be used as information sources, then WebMate constructs a query using the top several words in the current profile and sends it to popular search engines (see pg. 134, §3.2). WebMate does not disclose a search condition designating unit that designates a file as a search condition and transmits contents of a designated file via a network for a search requesting source in combination with a document search unit that forms a keyword from the file contents transmitted from a search conditioned designating unit that searches similar documents.

In contrast, the present invention has two units, a search conditioned designating unit and a document search unit. The search conditioned designating unit transmits contents of a file designated by a user. The document search unit forms a keyword from the transmitted contents and searches similar documents. Utilizing the present invention, a user can search documents that are similar to the contents of a designated file. That is, if a user has e-mail text in a file, then the user can search documents that are similar to the e-mail text by designating the file.

On the other hand, WebMate searches documents based on a similarity between a user profile and a document, and not according to a similarity between a document and another document. As a result, WebMate cannot search documents that are similar to contents of a file designated by the user. Since WebMate cannot search documents that are

similar to the contents of a file designated by a user, withdrawal of the §102 rejection of claim 1 is respectfully requested.

Since claims 2, 4-5 and 9 ultimately depend upon claim 1, they necessarily include all of the features of their associated independent claim plus additional features. Thus, Applicant submits that the §102 rejection of claims 2, 4-5, and 9 has also been overcome for the same reasons mentioned above to overcome the rejections of independent claim 1. Applicant respectfully requests that the §102 rejection of claims 2, 4-5, and 9 also be withdrawn.

Claims 3 and 6-8 stand rejected under 35 U.S.C. 103 over the WebMate, and further in view of the publication, “CiteSeer: An Autonomous Web Agent for Automatic Retrieval and Identification of Interesting Publications,” by Bollacker et al., proceedings of the International Conference on Autonomous Agents, May 1998, ACM Press, pages 116-123, hereinafter “CiteSeer,” and/or the Eichstaedt et al. (U.S Patent No. 6,182,085). Since claims 3 and 6-8 ultimately depend upon claim 1, they necessarily include all of the features of their associated independent claim plus additional features. Thus, Applicant submits that the §102 rejection of claims 3 and 6-8 has also been overcome for the same reasons mentioned above to overcome the rejections of independent claim 1, and also because the CiteSeer and Eichstaedt et al. references fail to overcome the deficiencies recited above with respect to the rejection of claim 1. Thus, Applicant respectfully requests that the §102 rejection of claims 3 and 6-8 also be withdrawn.

For all of the foregoing reasons, Applicant submits that this Application is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By   
Joseph P. Fox  
Registration No. 41,760

October 13, 2003

300 South Wacker Drive  
Suite 2500  
Chicago, Illinois 60606  
Telephone: (312) 360-0080  
Facsimile: (312) 360-9315  
Customer No. 24978  
K:\1990\65128\Amend A.doc